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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,271	01/22/2001	Takashi Sako	AA33/VB	5065

27752 7590 12/15/2005

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT PAPER NUMBER

1618

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,271

Applicant(s)

SAKO ET AL.

Examiner

D. L. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2005 and 25 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/25/05</u> . | 6) <input type="checkbox"/> Other: _____ |

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the amendment filed 1/25/05 wherein claims 1 and 10 were amended. In addition, the Examiner acknowledges receipt of the acceptable terminal disclaimer filed 1/25/05.

Note: Claims 1-10 are pending.

RESPONSE TO APPLICANT'S ARGUMENTS

2. The Applicant's arguments filed 1/25/05 to the rejection of claims 1-10 made by the Examiner under 35 USC 103, 112, and/or double patenting have been fully considered and deemed persuasive-in-part for the reasons set forth below.

Double Patenting Rejections

The double patenting rejection is WITHDRAWN because Applicant has submitted an acceptable terminal disclaimer.

112 Rejections

The 112 rejections are WITHDRAWN because Applicant has amended the claims to overcome the rejection.

103 Rejections

The rejection of claims 1-10 under 35 USC 103(a) as being unpatentable over Karlen et al (US Patent No. 6,004,545) in view of Hitchen (US Patent No. 6,106,816), Kang et al (WO 97/23194), and Rath et al (US Patent No. 5,993,792) is MAINTAINED for reasons of record in the office action mailed 10/25/04 and those set forth below.

Applicant's arguments may be summarized as follows. (1) The instant invention is distinguished over the cited prior art because the claims have been amended to read on a hair conditioning composition that is suitable for leave-on use. (2) The primary reference, Karlen et al does not disclose nor suggest a leave-on hair conditioning composition as now amended. (3) Kang et al neither suggest nor disclose a leave-on hair conditioning composition as now amended having a humectant comprising polyethylene glycol having a molecular weight of up to 1000. However, Kang et al does disclose compositions comprising propylene glycol, hexylene glycol, and pyrrolidone carboxylic acid. (4) The broad teachings in Hitchen directed to cationic polymeric conditioning agents in shampoo compositions and the general teachings disclosed in Rath directed to optical brighteners, herbal extracts, and UV absorbers would not lead one of skill in the art to the leave-in conditioners of the instant invention.

All of Applicant's arguments have been considered but are not found persuasive for the following reasons. First of all, Applicant is reminded that the intended use of a product in a claim does not carry patentable weight. However, a statement of intended use carries patentable weight in a method claim. Hence, since the claims are directed to a product, the intended use of that product (e.g., as a leave-on conditioner) is not given patentable weight. Furthermore, it should be noted that as stated in the previous office action, the combination of agents, each of which is known to be useful individually for the same purpose (i.e., as a hair cosmetic), into a single composition is obvious (see *In re Kerkhoven*, 205 USPQ 1069).

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In regards to Applicant's assertion that Karlen et al does not disclose or suggest a leave-on hair conditioning composition, Applicant is reminded that the rejection is a combination reference. Thus, a single reference (the primary reference) does not disclose all of the limitations of the claims, but the references in combination. Hence, since Karlen et al disclose a hair composition comprising copolymers of carboxylic acid, an amphoteric conditioning polymer, aqueous carriers, and silicon compounds, one of ordinary skill in the art would be motivated to combine the composition with those of the same field of endeavor. For example, each of the cited references is directed to hair compositions. In addition, it should be noted that Karlen et al in combination with Hitchen render obvious the use of hair conditioning compositions because review of Hitchen disclose that their composition is a conditioning composition that leaves the hair softer and more manageable (column 1, lines 13-16). Furthermore, it should be noted that as possible conditioning agents which may be incorporated into their compositions, Hitchen disclose that a graft cationic copolymer containing N-vinyl pyrrolidone, dimethylaminoethyl methacrylate, and polyethylene glycol may be utilized (column 5, lines 56-65). Hence, one of ordinary skill in the art would be motivated to use a humectant containing polyethylene glycol. A skilled practitioner in the art would be motivated to use the teachings of Kang et al in combination with those of Karlen et al and Hitchen because Kang et al disclose compositions that provide excellent conditioning and esthetic effects for the hair and such compositions comprise humectant, viscosity modifiers, visible particles, copolymers of carboxylic acid, an aqueous carrier, and silicon compounds. A skilled practitioner in the art would be

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motivated to use the teachings of Rath et al in combination with the other cited references because they are all directed to the same field of endeavor. Specifically, Rath et al discloses a system of preparing shampoo and conditioner compositions which may be customized. Polyethylene glycol derivatives may be incorporated into the compositions of Rath et al (column 3, lines 33-43 and column 5, lines 57-64). Also, it is noted that Rath et al allows the hair technician to customize their conditioning composition, for example. This would enable one to generate a product that may be specially formulated for an individual client's hair. The conditioner, for example, may vary from a pourable liquid to a relatively stiff viscous cream depending on the amount of conditioner thickening complex added (column 6, lines 55-61). Furthermore, it should be noted that Rath et al disclose some overlapping components for its shampoo and conditioner compositions. Also, while Rath et al disclose that the conditioner is left in the hair for 1-2 minutes and rinsed (column 13, lines 63-65), it does not state that the hair is thoroughly rinsed such that residual conditioner does not remain. Hence, since Rath et al disclose that the hair system may be customized to an individual client's hair, the reference does not set forth that ALL of the conditioner must be removed from the subject's hair. Thus, it is possible that a client needing more conditioning may receive a light rinsing of the conditioner composition instead of a thorough and intense rinsing of the conditioning composition. Furthermore, since some of the components of the shampoo and conditioner overlap, a skilled practitioner in the art would be motivated to generate a hair conditioning composition as set forth in the instant invention.

SPECIFICATION

3. Applicant is respectfully requested to submit a clean and readable copy of the specification. In particular, a clean copy of the specification is necessary because there are some markings through some of the text.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

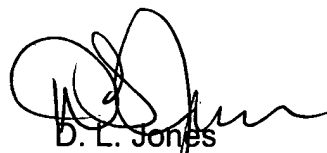
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones
Primary Examiner
Art Unit 1618

December 12, 2005